

REMARKS

Claims 1-20, 22, 23, 25-39 and 41-43 are currently pending in the subject application and are presently under consideration. Claims 1, 22, 39, 42 and 43 have been amended as shown at pages 2-10 of the Reply. In addition, claim 44 has been added.

Applicants' representative appreciates the Examiner's acknowledgement in the Office Action dated May 3, 2007 that claim 38 is allowable

Applicants' representative thanks Examiner Strange for the courtesies extended during the telephonic interview conducted on June 29, 2007. Examiner was contacted to discuss the claim rejection under 35 U.S.C. §103(a). During the interview a set of amendments and a new claim were agreed upon that were believed to overcome the cited references. These amendments have been incorporated into the claims as shown above. However, Examiner Strange indicated that further search and consideration was required to determine if the claims would be allowed over the cited prior art.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-20, 22, 23, 25-39 and 41-43 Under 35 U.S.C. §103(a)

Claims 1-20, 22, 23, 25-39 and 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Theimer, *et al.* (US 5,812,865) in view of Horvitz, *et al.* ("Attention-Sensitive Alerting"; Cited in IDS filed 5/27/03). This rejection should be withdrawn for at least the following reason. Theimer, *et al.* and Horvitz, *et al.* does not teach or suggest all the limitations of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The subject invention relates to analyzing data associated with parties involved in a communication attempt to identify the optimal one or more communication modalities to use in establishing the communication between the parties. For instance, if an employee wanted to contact a coworker, the invention could analyze the coworker's current attention state and preferred modality of communication to select the appropriate communication modality to establish, such as e-mail, voicemail, instant messaging, or a future meeting. Furthermore, applicant's claimed invention can determine an expected utility with establishing the communication based upon cost benefit determination associated with a communication modality. The expected utility can be used, for example, to rank potential communication modalities. In particular, independent claim 1 (and similarly recited in independent claims 22, 39, 42 and 43) recites *the communication manager establishing a communication between the entities via at least one modality of the subset based at least upon determining an expected utility associated with the communication, the expected utility is based at least in part on the subset of the communication modalities and the first and second communication data sets, the expected utility is based at least in part on cost benefit determination associated with at least one modality of the subset.*

As conceded in the Office Action dated May 3, 2007, Theimer *et al.* does not teach or suggest the aforementioned novel aspects of applicant's invention as recited in the subject claims. The cited art discloses a system for establishing communication data paths between media devices based upon the context of users of the devices. Theimer *et al.* employs a method that examines user preference data that establishes rules for how the user should be contacted under various contexts. The system then employs various solutions to enforce the rules such as a rules engine or policy modules. The current context of the user will be examined when a communication attempt is made to the user and the appropriate rule will be employed to determine if the message should be delivered and the device to employ. Column 27, line 60 to column 28, line 8 is cited discussing a "best connection method" as suggesting an expected utility. However, this section of the reference discusses employing user defined rules to match the preferred connection methods of the sender and recipient to establish the communication.

Again, this is merely identifying a matching communication modality, not determining an expected utility with respect to the transmitted communication. Theimer *et al.* takes an entirely rules based approach to establishing communication where if conditions of the rule are satisfied, the rule is executed. Although applicants' representative believes Theimer *et al.* is silent regarding determining an expected utility associated with the communication, independent claims 1, 22, 42 and 43 have been amended to further recite that the expected utility is based upon a cost benefit determination associated with communication modalities. Horvitz, *et al.* is cited to make up for the deficiencies of Theimer, *et al.* with respect to this novel feature. However, Horvitz, *et al.* discloses a cost benefit determination associated with interrupting a recipient at a particular time. The cited reference does not disclose a cost benefit determination associated with a particular communication modality as recited in the subject claims. Horvitz, *et al.* is concerned with determining an appropriate time to deliver a message to a recipient based upon the cost of interrupting the recipient versus the benefit of delivering the message. Therefore, Theimer, *et al.* and Horvitz, *et al.* fail to teach or suggest the communication manager establishing a communication between the entities via at least one modality of the subset based at least upon determining an expected utility associated with the communication, the expected utility is based at least in part on the subset of the communication modalities and the first and second communication data sets, the expected utility is based at least in part on cost benefit determination associated with at least one modality of the subset..

In view of at least the foregoing discussion, applicant's representative respectfully submits that Theimer *et al.* and Horvitz, *et al.*, alone or in combination, fail to teach or suggest all limitations of applicant's invention as recited in independent claims 1 and 22, 39, 42 and 43 (and claims that respectfully depend there from), and thus fails to anticipate the subject claimed invention. Accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP221US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,
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